

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

Claims 1-3 are currently pending in the present application. The Office Action is non-final. Claim 1 has been amended without prejudice or disclaimer of the subject matter contained therein. No new matter has been added by way of this amendment. Support for amended claim 1 can be found on page 10, line 14, to page 11, line 5, of the present specification, as well as Examples 1-6. Thus, no new matter has been added.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

Reconsideration of the presently pending claims is respectfully requested, especially in light of the comments below.

Issue Under 35 U.S.C. § 102(b), Anticipation

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as anticipated by a machine translation of Japanese Patent Application No. H09-012613 (hereinafter "JP '613"). Applicants respectfully traverse.

The Examiner asserts that JP '613 discloses a method of preparing a water-absorbent resin which includes a reverse-phase suspension polymerization that takes place in multiple steps. Further, the Examiner asserts that the process includes the addition of a phosphorous-

containing compound to the second step. See the Office Action dated December 18, 2008 at page 2. Applicants respectfully submit that JP '613 fails to disclose all claimed features.

Claim 1 has been amended, without prejudice or disclaimer, to require that the first step be without the presence of the phosphorus-containing compound in carrying out the polymerization reaction. JP '613 discloses a water-soluble ethylenically unsaturated monomer which is subjected to reverse phase suspension polymerization in multiple steps, and that a phosphorus-containing compound is used in a second step. Further, the water-absorbent resins of Examples 1 to 15 of JP '613 are obtained by subjecting a water-soluble ethylenically unsaturated monomer to a reverse phase suspension polymerization in two steps, where the reversed phase suspension polymerization is carried out in the presence of the phosphorus-containing compound in both the first and second steps of the polymerization reaction.

In contrast, as recited in the amended claim 1, the present invention includes the feature wherein a water-soluble ethylenically unsaturated monomer is subjected to reverse phase suspension polymerization by adding a phosphorus-containing compound to at least one step in the second and subsequent steps, without the presence of the phosphorus-containing compound in the first step. Since JP '613 is silent regarding not having the phosphorus-containing compound in the first step, the cited reference fails to anticipate the present invention. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited JP '613 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Therefore, with this feature, since the present invention is clearly distinguishable from the invention described in JP '613, the present invention is not anticipated by JP '613 because the reference does not teach or provide for each of the limitations recited in the pending claims.

For completeness, Applicants also respectfully submit that JP '613 does not render the present invention obvious because neither the reference nor the knowledge in the art provides any disclosure, reason, or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed.

As support of Applicants' position, and in order to further distinguish the present invention to that of JP '613, Applicants herein submit a Declaration pursuant to 37 C.F.R. § 1.132 by Mr. Tomoki Kawakita (a co-inventor of the present invention). The Rule 132 Declaration clearly shows the technical significance of carrying out a reverse phase suspension polymerization in the presence of a phosphorus-containing compound in at least one step in the second and subsequent steps, without the presence of the phosphorus-containing compound in the first step.

In the attached Rule 132 Declaration, a test was conducted on "water absorbent resin A" (see page 5 of Declaration) which was produced in the same manner as in Example 1 of the present application except that a phosphorus-containing compound is present in both the first and second step. Also, the amount of the phosphorus-containing compound was kept the same as in Comparative Example 2. For the Examiner's convenience, the results are reproduced below (and shown on page 8 of the Declaration):

		Addition of Phosphorus-Containing Compound		Water Absorption Rate (sec)	Amount of Water-Soluble Substance (% by weight)
		1st Step	2nd Step		
Present Invention	Ex. 1	-	Added	41	16
	Comp. Ex. 2	Added	-	70	35
Water-Absorbent Resin A		Added	Added	69	39

As can be seen above, it is clear from the results that if the phosphorus-containing compound is added in the first-step of the polymerization (Comparative Example 2 and water absorbent resin A), the water-absorption rate is inferiorly slower and the amount of water-soluble substance is higher.

Thus, it is evident that the present invention's features, which are a water-soluble ethylenically unsaturated monomer is subjected to reverse phase suspension polymerization by adding a phosphorus-containing compound to at least one step in the second and subsequent steps, without the presence of the phosphorus-containing compound in the first step, lead to superior, faster water-absorption rate with a smaller amount of water-soluble substance. Applicants respectfully submit that these are advantageous, unexpected results that is not obtained in the invention described in JP '613. *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Accordingly, the present invention is patentable over JP '613 for these additional reasons.

Applicants respectfully request reconsideration and withdrawal of the present rejection.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters within the present application that need to be resolved, the Examiner is respectfully requested to contact Paul D. Pyla, Reg. No. 59,228, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: March 18, 2009

Respectfully submitted,

By John P. Kelly #18, D1
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: 37 CFR 1.132 Declaration of Mr. Tomoki Kawakita